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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,886	12/21/2004	Glenn Edward Jones	2002B096/2	3493

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EXAMINER	
MULLIS, JEFFREY C	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
10/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,886	JONES ET AL.	
	Examiner	Art Unit	
	Jeffrey C. Mullis	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *03 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7,11,12,14-18,23,24,26-33,35-41,44,45 and 47-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,11,12,14-18,23,24,26-33,35-41,44,45 and 47-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24, 26-33, 35-41, 44, 45 and 47-50 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsou et al. (WO 01/85837).

Patentees disclose a composition having isobutylene elastomers and semicrystalline polymers (abstract) which include combinations of brominated butyl rubber and Exxon Exact plastomer , carbon black and curing agent (see the examples in Table 1 and especially examples 3-6). Natural rubber may be added at column 6, lines 9-21.Polybutene oil may be added in place of the FLEXON of the examples at page 10, lines 18-20.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1-5, 7, 11, 12, 14-18, 23, 24, 26-33, 35-41, 44, 45 , 47-50, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsou et al, cited above, optionally in view of any one of Wadell et al. (US 2005/0027062), Dias et al.(US 2004/0132894), Jones et al.(2004/0087704) or Waddell et al. (US2004/0030036), the secondary references al previously cited in the advisory action of 6-27-07.

Tsou et al discloses no examples using the specific isobutylene copolymer rubbers of claims 51 and 52 but discloses that they may be used at the paragraph bridging pages 8 and 9 and similarly with re to claims 1-5, 7, 11, 12, 14-18, 23, Tsou disclose no examples having all of the components in combination. However Tsou does disclose usage of applicants' individual components. Hence to arrive at applicants composition by selecting from the various disclosures of patentees would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results. Applicants remarks appear to disagree with the examiner that Tsou can be said to disclose examples having applicants amounts of polybutene oil in combination with applicants other components. However as set out '894 at paragraph 98, '704 at paragraph 58, 036 at paragraphs 67 and 69 and '062 at paragraph 175 which discloses

that use of polybutene oil decreases air permeability. Hence use of polybutene oil in amounts to minimize air permeability (a benefit in the composition of Tsou) or in amounts of other of other oils (in that the primary reference discloses interchangeability of polybutene oil and other oils) would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7, 11, 12, 14-18, 23, 24, 26-33, 35-41, 44, 45 and 47-52 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,875,813. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the generic terms recited by the patent claims are disclosed to include applicants specific species by the patent specification which thus supports the patent claims and is therefore properly relied on.

Ekdahl et al. at column 4, lines 55-59 discloses that polyethylene has a glass transition of minus 120 degrees while polypropylene has a Tg of minus 10 degrees. Kennedy, discloses at column 4, lines 62-67 that polyisobutylene has a Tg of minus 65 while Arens has a similar disclosure at column 4, lines 6-10. The above references were all previously cited.

Applicant's arguments filed 9-12-07 have been fully considered but they are not persuasive.

It is not the position of the examiner that any composition which can be obtained from choosing from within the various disclosures of Tsou anticipates applicants claims. In fact use of many of the individual components of Tsou as suggested by Tsou do not result in the claimed composition even ignoring applicants characteristics. Examples 2-4 in fact do not read on the instant claims rejected under 35 USC 102 at all for at least the reason that the polybutene oil required by claim 48 is not present. Tsou discloses that "polyisobutylene oil, can be used as a plasticizer in place of processing oils such as FLEXON ™ 876 used in the present examples" as set out in the above rejection. Replacement of the FLEXON oil of the examples with polybutene results in applicants composion including applicants amounts. Patentees disclose nothing about partial

replacement of FLEXON with polybutene oil. In any case, the references cited in the advisory action indicate that the effect of polybutene oil on air permeability was known at the time of the invention. Such substitution of the oils of the examples of Tsou results in a naphthenic/aromatic oil free composition and thus Tsou fully discloses applicants invention including plastomer densities which are explicitly disclosed in the examples. . While unexpected results are immaterial to anticipation, patentees distinguish between polyisobutylene oil and other plasticizers in the last paragraph in column 6 and imply that the air permeability problem can be overcome by use of polyisobutylene oil. With re to applicants allegation of unexpected results based on polybutene in natural rubber containing blends, none of the instant claims are limited to use of natural rubber.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

2-22-07

Jeffrey Mullis
Primary Examiner
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